

**REMARKS**

Claims 1-9, 11-24 and 26-35 are pending in this application. By this Amendment, claims 1 and 16 are amended and claims 10 and 25 are canceled. Support for the amendments to the claims may be found, for example, in the original claims. No new matter is added.

In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

**I. Rejection Under 35 U.S.C. §112**

The Office Action rejects claims 1-9, 12-24 and 27-35 under the enablement requirement of 35 U.S.C. §112, first paragraph. Specifically, the Office Action asserts that "because the specification, while being enabling for polyhydric alcohols with at least three hydroxyl group[s], one of which is a secondary hydroxyl group, does not reasonably provide enablement for *any* polyhydric alcohol," practicing and using the claimed invention would require undue experimentation. Applicants respectfully traverse the rejection.

Without conceding the propriety of the rejections, independent claims 1 and 16 are amended to obviate the rejection. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

**II. Rejections Under 35 U.S.C. §102**

**A. Seiden**

The Office Action rejects claims 1-3, 6-11, 13, 15-18, 21-26 and 28 under 35 U.S.C. §102(b) as being anticipated by GB 1458570 to Seiden et al. ("Seiden") when taken with Applicant's alleged admission. By this Amendment, claims 10 and 25 are canceled, rendering their rejection moot. As to the remaining claims, Applicants respectfully traverse the rejection.

Independent claims 1 and 16 are amended to recite a "A method of preparing an aliphatic polymer having a ketone group in a main chain thereof, wherein polyhydric alcohol which contains a secondary alcohol group and a primary alcohol group in a single molecule." Seiden does not, expressly or inherently, disclose such features.

Anticipation requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

Seiden discloses a process for preparing polyglycerol by heating glycerol under reduced pressure in the presence of sulfuric acid and a glyceride compound. See Seiden, pg. 1, lines 11-17 and pg. 2, lines 23-36. The Office Action acknowledges that Seiden does not disclose the formation of ketone groups in the main chain. Additionally, the Examples of Seiden teach that heating glycerol under reduced pressure in the presence of sulfuric acid and glyceride results in polyglycerol mixtures with a high content of linear diglycerols; the compositions shown in the Tables on pages 5 and 6 of Seiden contain no aliphatic polymer having a ketone group in the main chain. Thus, Seiden fails to disclose, expressly or inherently, each and every feature of claim 1 and, thus, does not anticipate claim 1.

Independent claims 1 and 16 are not anticipated by Seiden. Claims 2-3, 6-9, 11, 13, 15, 17-18, 21-24, 26 and 28 variously depend from claims 1 and 16 and, thus, also are not anticipated by Seiden.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

**B. Muller**

The Office Action rejects claims 1-9, 12, 13, 15-24, 27 and 28 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,849,515 to Muller ("Muller"). Applicants respectfully traverse the rejection.

As indicated above, Applicants' claim 1 includes polymerizing "polyhydric alcohol which contains a secondary alcohol group and a primary alcohol group in a single molecule." However, Muller discloses a process for preparing a polyether/polyester block copolymer by condensing hydroxyl polyesters and hydroxyl polyester in the presence of a catalyst. See Muller, Abstract. Thus, Muller fails to disclose a polyhydric alcohol containing a secondary alcohol group and a primary alcohol group in a single molecule and, thus, does not anticipate claim 1.

Independent claims 1 and 16 are not anticipated by Muller. Claims 2-9, 12, 13, 15, 17-24, 27 and 28 variously depend from claims 1 and 16 and, thus, also are not anticipated by Muller. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

**III. Rejections Under 35 U.S.C. §103**

The Office Action rejects claims 30-35 under 35 U.S.C. §103(a) as unpatentable over Muller in view of U.S. Publication No. 2003/0213939 to Narayan et al. ("Narayan").<sup>1</sup> Applicants respectfully traverse the rejection.

As discussed above, Muller fails to disclose, and likewise fails to teach or suggest, each and every limitation of independent claim 16, from which claims 30-35 depend. Narayan fails to cure this deficiency. At most, Narayan appears to disclose an electrically

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<sup>1</sup> The Notice of References Cited attached to the outstanding Office Action incorrectly notes reference "B" as U.S. Publication No. 2003/0213979 to Nakajima et al., rather than the correct reference of U.S. Publication No. 2003/0213939 to Narayan et al. Accordingly, Applicants respectfully request the appropriate correction.

conducted composition comprising polymeric foams and carbon nanotubes. See Narayan, Abstract. Nowhere does Narayan teach or suggest the use of a polyhydric alcohol containing a secondary alcohol group and a primary alcohol group in a single molecule.

Accordingly, claim 16 and dependent claims 30-35 are patentable because the applied references, considered either separately or combined, fail to teach all the features of independent claim 16. Reconsideration and withdrawal of the rejection are respectfully requested.

**IV. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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